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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,083	10/31/2003	Wesley Scott Ashton	ASHTON0009	9725

7590  
Wesley Scott Ashton  
8549 Black Foot Court  
Lorton, VA 22079

11/26/2008

EXAMINER
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RODRIGUEZ, RUTH C

ART UNIT	PAPER NUMBER
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3677

MAIL DATE	DELIVERY MODE
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11/26/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/697,083	<b>Applicant(s)</b> ASHTON, WESLEY SCOTT	
	<b>Examiner</b> RUTH C. RODRIGUEZ	<b>Art Unit</b> 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-27,31,36-39 and 42-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38,39,42-45,48 and 49 is/are allowed.
- 6) ☒ Claim(s) 21-27,31,36,37,46 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because figure 11 should include cross hatching for the bar and the opposite ends. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21-27 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr. (US 6,026,659) in view of Abramowitz (US 3,500,829) and Lefkowitz (US 4,676,752).

Kaping discloses a method to mounting a mouth and tongue stud (10). The method comprises the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). Kaping fails to disclose that the method further comprises dispensing a substance into a mouth, wherein the substance is selected from the group consisting of a breath freshener and a flavoring agent, the mouth and tongue stud also includes a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substance contains the substance and dispensing the substance into the wearer's mouth, wherein the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. However, Abramowitz teaches

a method for dispensing a substance (48) into an earlobe. The method comprising the steps of: (a) providing an ear stud including a means (14,16,44) for dispensing a substance (48) formed in a portion of the stud. The means for dispensing a substance contains the substance (Figs. 9 and 10). The stud further comprises a bar (14) having ends, a first end member (44) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (Figs. 9 and 10); (b) mounting the bar of the stud in an aperture formed in a wearer's earlobe (Fig. 10); and (c) dispensing the substance into the earlobe ( Fig. 10). Abramowitz teaches that the stud serves to conveniently and effectively deliver medication or perfume to an aperture in an earlobe allowing healing of the ear and clearing up of infections (C. 1, L. 37-48). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a method for dispensing a substance where the stud includes a means for dispensing a substance formed in a portion of the stud where the means for dispensing the substance contains the substance and the substance being dispensed as taught by Abramowitz in the method disclosed by Kaping with the stud is being used in the mouth and therefore the substance will be dispensed into the wearer's mouth since the fistula formed in the mouth or tongue allows healing of the mouth and clearing up of any infection at the fistula. Doing so, serves to deliver medication conveniently and effectively to a fistula in the wearer's mouth and tongue since both devices deal with piercing on the body. Additionally, Abramowitz teaches that the stud provides a known technique of dispensing a substance in order to combat infections during the healing period following a piercing

operation and therefore it would have been obvious to one having ordinary skill in the art that the stud applying medication to the interior of the fistula in the wearer's mouth and tongue where the medication is selected from a medication for use in the user's mouth just like the stud serves to deliver medication to an aperture in the earlobe during the healing period following a piercing operation. Kaping and Abramowitz fail to disclose that fail to disclose that the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth since after the substance is ejected from the reservoir (16), for the first time or any subsequent time, a vacuum is created in the reservoir and this vacuum will allow the flow of fluids into the reservoir. Since the stud is located in the wearer's mouth a mixture of air and saliva can flow into the reservoir. The saliva that flows into the reservoir will mix with the substance and dissolve the substance over time in the wearer's saliva and eventually the dissolved substance flows from the means for dispensing into the wearer's mouth. Abramowitz teaches that the stud can be used to deliver perfume but fails to teach that the stud dispenses a breath freshener or flavoring agent. Regarding to the substance being selected from the group consisting of a breath freshener and a flavoring agent, Lefkowitz teaches a device (10) being placed in wearer's mouth to dispense a flavoring agent and/or breath freshener (32) (L. 3-6 of the abstract).

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Lefkowitz teaches that the use of medications in combination with other fluids and/or flavoring (C. 3, L. 1-3) is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to dispense medication, fluids and/or flavoring as taught by Lefkowitz in the device taught by Kaping and modified in accordance with the teachings of Edwards so that the substance being selected from the group consisting of a breath freshener and a flavoring agent. Doing so, allows dispensing of a medication in combination with a breath freshener and/or flavoring agent. Especially since breath freshener and flavoring agents are used to provide pleasant fragrances for the user's mouth just like the perfume taught by Abramowitz provides a pleasant fragrance to the use of the earring.

Lefkowitz also teaches that:

- The substance comprises a breath freshener (C. 3, L. 1-3).
- The substance comprises a flavoring agent (C. 3, L. 1-3).
- The substance includes a breath freshener mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener (C. 3, L. 1-3).
- A medication is mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener and the flavoring agent (C. 3, L. 1-3).

Regarding claim 36, the same rejection of claim 21 serves to reject claim 36 since the claim limitations are almost the same and Kaping disclose that the bar is a straight bar made of metal (C. 4, L. 48-67) and the material identification in the drawings of

Abramowitz indicate that the bar is made of metal that is a solid and the drawings show that the bar is a straight bar. Therefore, the bar discloses by Abramowitz is a straight (as shown in the drawings) solid (made of metal that is solid) bar (as shown in the drawings). The means for dispensing a substance is formed in one or both of the first end member and the second end member (opening at the end of member 16).

For claim 46, Kaping disclose that the bar is a straight bar made of metal (C. 4, L. 48-67) and the material identification in the drawings of Abramowitz indicate that the bar is made of metal that is a solid and the drawings show that the bar is a straight bar. Therefore, the bar discloses by Abramowitz is a straight (as shown in the drawings) solid (made of metal that is solid) bar (as shown in the drawings). The means for dispensing the substance is formed in the second end member (opening at the end of member 16).

4. Claims 31, 37 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr. (US 6,026,659) in view of Abramowitz (US 3,500,829).

Kaping discloses a method to mounting a mouth and tongue stud (10). The method comprises the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). Kaping fails to disclose that the method further comprises dispensing a substance into a mouth, wherein the substance is selected from the group consisting of a breath freshener and a flavoring agent, the mouth and tongue stud also includes a means for



dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substance contains the substance and dispensing the substance into the wearer's mouth, wherein the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. However, Abramowitz teaches a method for dispensing a substance (48) into an earlobe. The method comprising the steps of: (a) providing an ear stud including a means (14,16,44) for dispensing a substance (48) formed in a portion of the stud. The means for dispensing a substance contains the substance (Figs. 9 and 10). The stud further comprises a bar (14) having ends, a first end member (44) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (Figs. 9 and 10); (b) mounting the bar of the stud in an aperture formed in a wearer's earlobe (Fig. 10); and (c) dispensing the substance into the earlobe ( Fig. 10). Abramowitz teaches that the stud serves to conveniently and effectively deliver medication or perfume to an aperture in an earlobe allowing healing of the ear and clearing up of infections (C. 1, L. 37-48). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a method for dispensing a substance where the stud includes a means for dispensing a substance formed in a portion of the stud where the means for dispensing the substance contains the substance and the substance being dispensed as taught by Abramowitz in the method disclosed by Kaping with the stud is being used in the mouth and therefore the substance will be dispensed into the wearer's mouth since the fistula formed in the mouth or tongue allows healing of the mouth and clearing up of any

infection at the fistula. Doing so, serves to deliver medication conveniently and effectively to a fistula in the wearer's mouth and tongue since both devices deal with piercing on the body. Additionally, Abramowitz teaches that the stud provides a known technique of dispensing a substance in order to combat infections during the healing period following a piercing operation and therefore it would have been obvious to one having ordinary skill in the art that the stud applying medication to the interior of the fistula in the wearer's mouth and tongue where the medication is selected from a medication for use in the user's mouth just like the stud serves to deliver medication to an aperture in the earlobe during the healing period following a piercing operation.

Kaping and Abramowitz fail to disclose that the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth since after the substance is ejected from the reservoir (16), for the first time or any subsequent time, a vacuum is created in the reservoir and this vacuum will allow the flow of fluids into the reservoir. Since the stud is located in the wearer's mouth a mixture of air and saliva can flow into the reservoir. The saliva that flows into the reservoir will mix with the substance and dissolve the substance over time in the wearer's saliva and eventually the dissolved substance flows from the means for dispensing into the wearer's mouth.

Regarding claim 37, the same rejection of claim 21 serves to reject claim 37 since the claim limitations are almost the same and Kaping disclose that the bar is a straight bar made of metal (C. 4, L. 48-67) and the material identification in the drawings of Abramowitz indicate that the bar is made of metal that is a solid and the drawings show that the bar is a straight bar. Therefore, the bar discloses by Abramowitz is a straight (as shown in the drawings) solid (made of metal that is solid) bar (as shown in the drawings). The means for dispensing a substance is formed in one or both of the first end member and the second end member (opening at the end of member 16).

For claim 47, the bar is a solid bar (as explained above) and the means for dispensing the substance is formed in the second end member (opening at the end of member 16).

5. Claims 21-27, 36 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr. (US 6,026,659) in view of Edwards (US 4,943,274) and Lefkowitz (US 4,676,752).

Kaping discloses a method to mounting a mouth and tongue stud (10). The method comprises the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). Kaping fails to disclose that the method further comprises dispensing a substance into a mouth, wherein the substance is selected from the group consisting of a breath

freshener and a flavoring agent, the mouth and tongue stud also includes a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substance contains the substance and dispensing the substance into the wearer's mouth, wherein the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. However, Edwards teaches a method for dispensing a substance (22) into an earlobe. The method comprising the steps of: (a) providing an ear stud including a means (16,30,38) for dispensing a substance (22) formed in a portion of the stud. The means for dispensing a substance contains the substance (Figs. 1-4). The stud further comprises a bar (30) having ends, a first end member (50) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (Figs. 1-4); (b) mounting the bar of the stud in an aperture formed in a wearer's earlobe (Fig. 2); and (c) dispensing the substance into the earlobe (C. 3, L. 3-10). Edwards teaches that the stud serves to conveniently and effectively deliver medication to an aperture in an earlobe during the healing period following a piercing operation (C. 1, L. 32-35) and the stud serves to apply medication to the interior of the aperture in the earlobe (C. 3, L. 9-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a method for dispensing a substance where the stud includes a means for dispensing a substance formed in a portion of the stud where the means for dispensing the substance contains the substance and the substance being dispensed as taught by Edwards in the method disclosed by Kaping with the stud is being used in the mouth and therefore the substance

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will be dispensed into the wearer's mouth since the fistula formed in the mouth or tongue is also prone to infections during the healing period following a piercing operation. Doing so, serves to deliver medication conveniently and effectively to a fistula in the wearer's mouth and tongue since both devices deal with piercing on the body. Additionally, Edwards teaches that the stud provides a known technique of dispensing a substance in order to combat infections during the healing period following a piercing operation and therefore it would have been obvious to one having ordinary skill in the art that the stud applying medication to the interior of the fistula in the wearer's mouth and tongue where the medication is selected from a medication for use in the user's mouth just like the stud serves to deliver medication to an aperture in the earlobe during the healing period following a piercing operation. Kaping and Edwards fail to disclose that fail to disclose that the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth since after the substance is ejected from the reservoir (16), for the first time or any subsequent time, a vacuum is created in the reservoir and this vacuum will allow the flow of fluids into the reservoir. Since the stud is located in the wearer's mouth a mixture of air and saliva can flow into the reservoir. The saliva that flows into the reservoir will mix with the substance and dissolve the substance over time in the wearer's

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saliva and eventually the dissolved substance flows from the means for dispensing into the wearer's mouth. Regarding to the substance being selected from the group consisting of a breath freshener and a flavoring agent, Lefkowitz teaches a device (10) being placed in wearer's mouth to dispense a medication and/or breath freshener (32) (L. 3-6 of the abstract). Lefkowitz teaches that the use of medications in combination with other fluids and/or flavoring (C. 3, L. 1-3) is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to dispense medication, fluids and/or flavoring as taught by Lefkowitz in the device taught by Kaping and modified in accordance with the teachings of Edwards so that the substance being selected from the group consisting of a breath freshener and a flavoring agent. Doing so, allows dispensing of a medication in combination with a breath freshener and/or flavoring agent.

Lefkowitz also teaches that:

- The substance comprises a breath freshener (C. 3, L. 1-3).
- The substance comprises a flavoring agent (C. 3, L. 1-3).
- The substance includes a breath freshener mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener (C. 3, L. 1-3).
- A medication is mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener and the flavoring agent (C. 3, L. 1-3).

Regarding claim 36, the same rejection of claim 31 serves to reject claim 36 since the claim limitations are almost the same and Kaping disclose that the bar is a straight solid bar made of metal (C. 4, L. 48-67) and the material identification in the drawings of Edwards indicate that the bar is made of metal that is a solid and the drawings show that the bar is a straight bar. Therefore, the bar discloses by Kaping is a straight (as shown in the drawings) solid (made of metal that is solid) bar (as shown in the drawings). The means for dispensing a substance is formed in one or both of the first end member and the second end member (opening at the end of member 16).

Regarding to claim 46, the rejection of claim 36 serves to reject claim 46 since it includes the limitation a solid bar and how this limitation is interpreted and the means for dispensing the substance is formed in the second end member (16 is part of the means for dispensing the substance as shown in Figs. 1-4).

6. Claims 31, 37 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr. (US 6,026,659) in view of Edwards (US 4,943,274).

Kaping discloses a method to mounting a mouth and tongue stud (10). The method comprises the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). Kaping fails to disclose that the method further comprises dispensing a substance into a mouth, wherein the substance is medicine, the mouth and tongue stud also

includes a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substance contains the substance and dispensing the substance into the wearer's mouth, wherein the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth.

However, Edwards teaches a method for dispensing a substance (22) into an earlobe.

The method comprising the steps of: (a) providing an ear stud including a means (16,30,38) for dispensing a substance (22) formed in a portion of the stud. The means for dispensing a substance contains the substance (Figs. 1-4). The stud further comprises a bar (30) having ends, a first end member (50) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (Figs. 1-4); (b) mounting the bar of the stud in an aperture formed in a wearer's earlobe (Fig. 2); and (c) dispensing the substance into the earlobe (C. 3, L. 3-10). Edwards teaches that the stud serves to conveniently and effectively deliver medication to an aperture in an earlobe during the healing period following a piercing operation (C. 1, L. 32-35) and the stud serves to apply medication to the interior of the aperture in the earlobe (C. 3, L. 9-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a method for dispensing a substance where the stud includes a means for dispensing a substance formed in a portion of the stud where the means for dispensing the substance contains the substance and the substance being dispensed as taught by Edwards in the method disclosed by Kaping with the stud is



being used in the mouth and therefore the substance will be dispensed into the wearer's mouth since the fistula formed in the mouth or tongue is also prone to infections during the healing period following a piercing operation. Doing so, serves to deliver medication conveniently and effectively to a fistula in the wearer's mouth and tongue since both devices deal with piercing on the body. Additionally, Edwards teaches that the stud provides a known technique of dispensing a substance in order to combat infections during the healing period following a piercing operation and therefore it would have been obvious to one having ordinary skill in the art that the stud applying medication to the interior of the fistula in the wearer's mouth and tongue where the medication is selected from a medication for use in the user's mouth just like the stud serves to deliver medication to an aperture in the earlobe during the healing period following a piercing operation. Kaping and Edwards fail to disclose that the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth since after the substance is ejected from the reservoir (16), for the first time or any subsequent time, a vacuum is created in the reservoir and this vacuum will allow the flow of fluids into the reservoir. Since the stud is located in the wearer's mouth a mixture of air and saliva can flow into the reservoir. The saliva that flows into the reservoir will mix with the

substance and dissolve the substance over time in the wearer's saliva and eventually the dissolved substance flows from the means for dispensing into the wearer's mouth.

Regarding claim 37, the same rejection of claim 31 serves to reject claim 37 since the claim limitations are almost the same and Kaping disclose that the bar is a straight solid bar made of metal (C. 4, L. 48-67) and the material identification in the drawings of Edwards indicate that the bar is made of metal that is a solid and the drawings show that the bar is a straight bar. Therefore, the bar discloses by Kaping is a straight (as shown in the drawings) solid (made of metal that is solid) bar (as shown in the drawings). The means for dispensing a substance is formed in one or both of the first end member and the second end member (opening at the end of member 16).

Regarding to claim 47, the rejection of claim 37 serves to reject claim 47 since it includes the limitation a solid bar and how this limitation is interpreted and the means for dispensing the substance is formed in the second end member (16 is part of the means for dispensing the substance as shown in Figs. 1-4).

#### ***Allowable Subject Matter***

7. Claims 38, 39, 42-45, 48 and 49 are allowed.

#### ***Response to Arguments***

8. Applicant's arguments filed 23 July 2008 have been fully considered but they are not persuasive.

9. The Applicant argues that the device of Abramowitz is a syringe and that it can not be considered a mouth and tongue stud. This argument fails to persuade. The device of Abramowitz can be considered a syringe since it ejects medication, however, this device can also be considered a stud since Abramowitz teaches that the device remains engaged to the pierced opening. Therefore, the device can be considered a mouth and tongue stud when this device is used to modify the mouth and stud device that is disclosed by Kapling.

10. The Applicant argues that Abramowitz fails to disclose a straight solid bar since the bar is hollow. This argument fails to persuade since the bar is made of metal and metal is a solid. The Examiner revised the rejection of the claims in order to clarify that since the stud is made of metal it is a solid.

11. The Applicant argues that the device taught by Edwards has a retainer (52) held in place by friction and that such a retainer is undesirable for use in the mouth. This argument fails to persuade since the rejection is not incorporating the retainer 52. The rejection is based in the patent by Kapling that discloses two ends that are securely held to the bar and the elements being incorporated into the device of Kapling are the end 16 and the perforated bar 30. The retainer 52 is not incorporated into the device since Kapling already has another end that remains unchanged.

12. The Applicant argues that the stud can not be used to enhance sexual activity since the end 16 is compressible. This argument fails to persuade since one of the solid ends disclosed by Kapling that will remain unchanged in the device can serve to enhance sexual activity.

13. The Applicant argues that the device of Edwards is a syringe and that it can not be considered a mouth and tongue stud. This argument fails to persuade. The device of Edwards can be considered a syringe since it ejects medication, however, this device can also be considered a stud since Edwards teaches that the device remains engaged to the pierced opening. Therefore, the device can be considered a mouth and tongue stud when this device is used to modify the mouth and stud device that is disclose by Kapling

14. The Applicant argues that Edwards fails to disclose a straight solid bar since the bar is hollow. This argument fails to persuade since the bar is made of metal and metals is a solid. The Examiner revised the rejection of the claims In order to clarify that since the stud is made of metal it is a solid.

15. The Applicant argues that none of the reference teaches that the substance is disposed using saliva. This argument fails to persuade since the office action addressed this point. The device is located in the mouth and saliva will enter the reservoir when part of the substance is ejected into the mouth. The saliva that enter the reservoir will dissolve the substance and will be ejected out of the reservoir when the substance is ejected from the reservoir again.

16. The Applicant argues that the combination is improper because there is no reason to combine the references of Kapling and Abramowitz or Kapling and Edwards. The Examiner fails to be persuaded by this argument because "Abramowitz teaches that the stud serves to conveniently and effectively deliver medication or perfume to an aperture in an earlobe allowing healing of the ear and clearing up of infections (C. 1, L.

37-48).” as recited above for the rejection of the claims and “Edwards teaches that the stud serves to conveniently and effectively deliver medication to an aperture in an earlobe during the healing period following a piercing operation (C. 1, L. 32-35) and the stud serves to apply medication to the interior of the aperture in the earlobe (C. 3, L. 9-10).” as recited above. The combination of Kapling and Abramowitz or Kapling and Abramowitz will yield a mouth and tongue stud that serves to deliver medication to a fistula formed in the wearer’s tongue or in the wearer’s lip since the fistula also experiences healing after the fistula is formed or it can experience infections. The Examiner acknowledges that the medication used in the mouth is different from the medication used in the earring since they are located in different environments. A person of ordinary skill in the art can determine that the medication used for the mouth and tongue stud needs to be different from the medication being used with the ears because of their locations. Additionally, there is a wide selection of the appropriate medications for use in the mouth that is commonly used to treat infections and a person of ordinary skill in the art will use select these medication when treating the mouth.

17. The Examiner acknowledges that Lefkowitz fails to disclose the mouth and tongue being claimed. However, Lefkowitz serves as proof that there are medications for use in the mouth and that some of these medications can have breath deodorizers.

In response to applicant's argument that there is no reasonable expectation of success even if the combinations were made, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested

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in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Abramowitz and Edwards teach that medication can be dispensed through a stud placed in a body piercing and both structures will perform its function of dispensing a substance equally as well regardless of whether it is located in the mouth or in the ear.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RUTH C. RODRIGUEZ whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor D. Batson can be reached on (571) 272-6987.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

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/RCR/  
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